

REMARKS

Claims 35-49 are pending in this application of which claims 35 and 41 are independent. Claims 35-39 and 41-49 stand rejected. Claim 40 has been objected to. For the following reasons, it is submitted that this application stands in condition for allowance.

Acknowledgement of the Information Disclosure Statement

The Examiner has yet to acknowledge receipt of, and appropriately initial, the Information Disclosure Statement (IDS) submitted concurrently with the filing of the above-identified application. Appropriate acknowledgement of the IDS and an indication of consideration of the references is respectfully solicited.

Priority Applications

The record has not acknowledged the claims for foreign and domestic priority under 35 U.S.C. §§ 119 and 120, respectively. Reference is made to items 4 and 9 of the Office Request For Filing (Rule 53(b)(1)) form submitted with the above-identified application. This form lists prior U.S. and foreign application information from which priority has been claimed. Appropriate acknowledgement is respectfully solicited.

Claim Rejections

Claims 41-49 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for having an antecedent basis deficiency with respect to the phrase "pre-formed substrate" on lines 12-13. The Office Action suggests inserting "pre-formed" before "substrate" in line 11, to provide correct antecedent basis. In accordance with the Examiner's suggestion, claim 41 has been amended. Withdrawal of the rejection is

therefore respectfully solicited, as the rejection has now been overcome. As claims 41-49 have not been otherwise rejected, it is submitted that these claims are now allowable.

Objection has been made to claim 40, which is indicated as being allowable if appropriately rewritten in independent form. Claims 35-39 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Zedalis et al. ("Zedalis") (U.S. Patent No. 4,946,500). The rejection is respectfully traversed.

Regarding claim 35, the Office Action asserts that Zedalis discloses the mixing, compacting, and sintering steps of claim 35, but acknowledges that Zedalis is silent with regard to the sintering atmosphere. The Office Action then states the following:

It is common knowledge in the prior art to sinter aluminum composites in inert atmospheres, including nitrogen, low moisture, low oxygen atmospheres to prevent contamination of the sintered composite, and to use such an atmosphere in the invention of Zedalis et al. would be obvious to prevent contamination.

The Examiner has not established support in any prior art of record of such "common knowledge," nor moreover, any motivation to combine in the suggested manner. Reconsideration of the conclusion at obviousness is respectfully solicited.

In the application of a rejection under 35 U.S.C. §103, it is incumbent upon the Examiner to factually support a conclusion of obviousness. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997); *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). As stated in *Graham v. John Deere Co.* 383 U.S. 1, 13, 148 USPQ 459, 465 (1966), obviousness under 35 U.S.C. §103 must be determined by considering (1) the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims in issue; and (3) resolving the level of ordinary skill in the pertinent art. The Examiner also must provide a reason why one having ordinary skill in the art would

have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). The Examiner should recognize that the fact that the prior art *could* be modified so as to result in the combination proposed in an effort to meet the claims would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). In the absence of such a prior art suggestion for modification of the references, the basis of the rejection is no more than inappropriate hindsight reconstruction using appellant's claims as a guide. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967).

In order to establish a *prima facie* case of obviousness, the Examiner must factually support a conclusion of obviousness. A statement of "common knowledge" without any factual support in the prior art of record does not meet this legal requirement. Moreover, the prior art must suggest the desirability of the modification. The Examiner has not established how Zedalis, or any other prior art of record, suggests the desirability to modify Zedalis to prevent contamination by sintering with the suggested atmosphere conditions. In fact, Zedalis is absent any discussion of atmosphere conditions in any manner and any steps taken to prevent contamination. Thus, a conclusionary statement to this affect is legally insufficient.

It is further noted that "inert atmospheres, including nitrogen, low moisture, low oxygen," as suggested by the Examiner, are some features of dependent claims 35-39. Zedalis does not suggest using the atmosphere conditions suggested by the Examiner.

Without any factual evidence to support the conclusions of obviousness, such conclusions can only be based on inappropriate hindsight reconstruction. Thus, the Office Action has failed to meet the initial burden to support a *prima facie* case of obviousness discussed above. Withdrawal of the rejection is respectfully solicited.

Accordingly, the application stands in condition for allowance. If the Examiner has any questions regarding this response or the application in general, the Examiner is encouraged to contact the undersigned attorney in order expedite prosecution of this case.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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